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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,402	07/05/2000	Jonathan Stephen Levkoff	MSGNT-001	4157

26137 7590 04/07/2004

PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
FOUR TIMES SQUARE
NEW YORK, NY 10036

EXAMINER

LE, HIEU C

ART UNIT PAPER NUMBER

2142

DATE MAILED: 04/07/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/610,402

Applicant(s)

LEVKOFF ET AL.

Examiner

Hieu c. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16, 22, 29 and 32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-13, 22, 29 and 32 is/are rejected.
- 7) ☒ Claim(s) 14-16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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1. Applicant's election without traverse of group II (11-16,22,29,32) in Paper No. 11 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 30 is rejected under 35 U.S.C. 102(b) as anticipated by Osaku et al. et al (US Patent 6,061, 837).

As to claim 30, Osaku discloses a method for generating a valid alias, comprising:

storing attributes, the attributes corresponding to user entered information [a client access information (attributes) are stored in a file and when owner (user) registers a URL numeric code(alias) additional information is obtained and added to the database (col. 25, lines 39-52)]; receiving user information for a number of attributes from said stored attributes and generating an alias by employing said user information, [the registered URL numeric code (alias) is selected based on user's telephone number; birth date, vehicle number, house number, room number or musical tones (attributes) (col. 15, lines 54-65)] wherein the number of attributes are selected so as to result in a valid alias generated (col. 15, lines 46-53).

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4. Claim 29 is rejected under 35 U.S.C. 102(e) as anticipated by Thomas et al (US Patent 6, 421, 339).

As to claim 29, Thomas discloses a method for facilitating the transmission of a message to a user of a message system, the message system employing aliases to define device sets associated with users of the message system, the message system transmitting a message to user devices associated with an alias when the alias is the intended recipient of the message, the method comprising:

providing service providers access to database records [each gate keeper (service provider) maintains a database (col. 4, lines 24-27)], a database record includes at least a user device identifier and a corresponding user alias [the database registers user terminal alias for a terminal (device) and a current IP address (device identifier) (col. 4, lines 1-7)],

making a communication link available for transmitting messages from the service provider to the message system [in Fig. 1, the visiting user 42 is provided a connection to his home network];

receiving messages from the service provider, the messages including a user alias as the intended recipient of the message (col. 4; lines 31-44).

forwarding the message to the users of the message system (col. 6, lines 13-20).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 11-13 are rejected under 35 U.S.C. 103(a) unpatentable as being Edelstein et al. (US Patent 5,764, 906) and in view of Kane et al (US Patent 5,487, 100)

As to claim 11, Edelstein discloses a method for transmitting a message to a recipient, the recipient is associated with an alias identifier, the alias identifier is associated with at least one permission criteria, the alias identifier is further associated with at least one communication device, comprising:

selecting a user alias (col. 3; lines 43-49)

verifying that the selected alias is for a registered recipient (col. 12; lines 1-17, col. 13, lines 25-35).

checking the permission criteria associated with the alias [the delivery services to clients employs a number of electronic or non electronic devices such as fax; telephone and postal service, the user may request to deliver the message by fax or in printed form by mail (col. 7, lines 4-11) (i.e. permission criteria associated with the alias)].

sending the message to a recipient device associated with the selected alias (col. 3, lines 59-60, col. 7, lines 4-15)].

Edelstein does not disclose,

compiling a message for the recipient;

checking the message length of the compiled message;

notifying the sender of the receipt of the message.

Kane discloses an e-mail message delivery system that deliveries e-mail from originating devices to destination devices using alias (col. 1, lines 65-col. 2, line 7). The messages are accumulated for each subscriber in a message database (compiled) (col. 5, lines 24-34). The system determines a maximum message length to be communicated to limit the size of the message and the bandwidth of the communication channel (col. 7, lines 62-col. 8, line 13).

The system notifying the sender of the receipt of the message (col. 6, lines lines 17-20, col. 7, lines 55-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Kane's teachings to modify the method of Edelstein by compiling received messages; checking the message length of the complied message; notifying the sender of the receipt of the message in order to limit and conserve the bandwidth of the communication channel and enable subscribers to better manage their the costs of receiving messages.

Claim 12 is a broad version of claim 11 and is rejected for the same grounds in claim 11.

As to claim 13, Kane further discloses,
retrieving a maximum message length for a communication device
associated with the identifier (col, 7, lines 63-66);
determining the message length of the received message (col. 8; lines 11-14).
comparing the message length of the received message to the maximum

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message length; and modifying the transmission of the message when the message length of the received message exceeds the maximum message length (col. 8, lines 14-17).

As to claim 22, Kane further discloses wherein said identifier is associated with at least one alias, said receiving comprising receiving a recipient alias, the recipient alias associated with said communication device via said unique identifier [destination address (identifier) is converted to a selective call receiver address that uniquely identifier the receiving device 130 and also much shorter in length than address information (i.e, alias) for the destination (col. 6, line 60-col. 7, line 2)].

Allowable Subject Matter

7. Claims 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached on (703) 305-9705. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hieu Le


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER